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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,753	07/20/2005	Nobuhiro Yabunouchi	28955.1053	1609
<div>27890 7590 01/25/2008</div> <div>STEPTOE & JOHNSON LLP</div> <div>1330 CONNECTICUT AVENUE, N.W.</div> <div>WASHINGTON, DC 20036</div>				
			EXAMINER	
			CHOI, LING SIU	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			01/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/542,753

Applicant(s)

YABUNOUCHI ET AL.

Examiner

Ling-Siu Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 13 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13, 15, 16 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/24/07, 7/20/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Amendment and the Declaration, both being filed 11/05/2007. Claims 10-11 and 14 were canceled and claims 24-27 have been added. Claims 1-9, 12-13, and 15-27 are now pending, wherein claims 17-23 had been withdrawn due to the Restriction/Election requirement.

2. The rejections of claims 1, 5-9, 13, and 15-16 under 35 U.S.C. 102(b) as being anticipated by Kioka et al. (US 5,055,528) and the rejection of claims 1-13, and 15-16 under 35 U.S.C. 103(a) as being unpatentable over Kioka et al. (US 5,055,528) in view of Yukimasa et al. (US 6,423,782 B1) are maintained.

Claim Analysis

3. Summary of claim 1:

A solid catalyst component for olefin polymerization obtained by reacting the following compounds (i), (ii) and (iv); or (i), (ii), (iii) and (iv):	
i	a halogen-containing titanium compound;
ii	an alkoxy-containing magnesium compound obtained by reacting metal magnesium, an alcohol and a halogen and/or a halogen-containing compound containing at least 0.0001 gram atom of halogen atoms per mol of the metal magnesium;
iii	a halogen-containing silicon compound: $\text{Si}(\text{OR}^9)_r\text{X}_{4-r}$ X = a halogen atom; R^9 = a hydrocarbon group; and r = an integer of 0 to 3

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iv	<p>an electron-donating compound represented by the following general formula (I):</p> $R^2-O-(C=O)-C(R^1)(H)-(C=O)-O-R^3$ <p>R^1 = a linear or branched $C_{>1}$ alkyl group; and</p> <p>R^2 and R^3 = a linear or branched C_{1-20} alkyl group.</p>
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Summary of claim 9:

<p>A solid catalyst component for propylene-ethylene copolymerization obtained by reacting the following compounds (a), (b) and (c); or (a), (b), (c) and (d):</p> <p>the solid catalyst component obtained by contacting the compounds (a) and (c); or (a), (c) and (d) with the compound (b) at 120 to 150°C, and thereafter washing the contact product with an inert solvent at 100 to 150°C:</p>	
a	an alkoxy-containing magnesium compound obtained by reacting metal magnesium, an alcohol and a halogen and/or a halogen-containing compound containing at least 0.0001 gram atom of halogen atoms per mol of the metal magnesium
b	a titanium compound;
c	<p>an electron-donating compound represented by the following general formula (II): and</p> $R^2-O-(C=O)-C(R^4)(R^5)-(C=O)-O-R^3$ <p>wherein R^2 and R^3 = a linear or branched C_{1-20} alkyl group;</p> <p>R^4 = a linear, branched or cyclic C_{1-20} alkyl group;</p> <p>R^5 = H or C_{1-2} alkyl group</p>
d	<p>a silicon compound: $Si(OR^{15})_tX_{4-t}$</p> <p>X = a halogen atom; R^9 = a hydrocarbon group; and t = an integer of 0 to 4</p>

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5-9, 13, 15-16, and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kioka et al. (US 5,055,528).

The rejection is adequately set forth in paragraph 8 of the Office Action dated 05/03/2007 and is incorporated herein by reference.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9, 12-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kioka et al. (US 5,055,528) in view of Yukimasa et al. (US 6,423,782 B1).

The rejection is adequately set forth in paragraph 10 of the Office Action dated

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05/03/2007 and is incorporated herein by reference.

Response to Arguments

8. Applicant's arguments filed 11/05/2007 have been fully considered but they are not persuasive.

Applicants: "Kioka discloses the use of alkoxy magnesium halides (see Kioka at col. 6, lines 23-26); however, Kioka does not disclose an alkoxy-containing magnesium compound that is obtained by reacting metal magnesium, an alcohol and a halogen and/or a halogen-containing compound containing at least 0.0001 gram atom of halogen atoms per mol of the metal magnesium. The use of the claimed alkoxy-containing magnesium compound achieves a high catalyst activity and a polymer with excellent powder morphology as evidenced in the attached **Declaration of Shojiro Tanase.**"

It is noted that the claims are drawn to product-by-process claims. The caselaw has held that "[t]he patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698,227 USPQ 964, 966 (Fed. Cir. 1985). Thus, the process to make the alkoxy-containing magnesium compound does not carry the patentable weight. Furthermore, the Declaration of Shojiro Tanase does not demonstrate the unexpected result resulted from the

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comparison of the alkoxy-containing magnesium compounds obtained by the present process and the process disclosed by Kioka et al. Attention is drawn to Example 1 of the disclosure of Kioka et al., wherein the alkoxy-containing magnesium compounds is prepared by contacting "[a]nhydrous magnesium chloride (7.14 g; 75 mmoles), 37.5 ml of decane and 35.1 ml (225 mmoles) of 2-ethylhexyl alcohol.....to form a uniform solution."

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

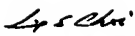
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-

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1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.


LING-SUI CHOI
PRIMARY EXAMINER

January 15, 2008